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08/908,994

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Michael J. Horgan

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EXAMINER

LANIER, BENJAMIN E

ART UNIT

PAPER NUMBER

2432

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|---------------------------------------|--------------------------------------|--|
| Office Action Summary | Application No. 08/908,994 | Applicant(s) HORGAN ET AL. | |
| | Examiner BENJAMIN E. LANIER | Art Unit 2432 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claim Objections

1. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claims 14, 18-20 have been renumbered 11-14.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claim 2 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. A claimed process is surely patent-eligible under § 101 if: (1) it is tied to a particular machine or apparatus, or (2) it transforms a particular article into a different state or thing. See Benson, 409 U.S. at 70; Diehr, 450 at U.S. at 192; see also Flook, 437 U.S. at 589 n.9. The mere field-of-use limitations are generally insufficient to render an otherwise ineligible process claim patent-eligible. See Diehr, 450 at U.S. at 191-92. In this case, the claims are considered non-statutory because the claimed process is not tied to a particular machine or apparatus.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 12-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6. Claim 12 recites the limitation "said interfaces" in line 2. There is insufficient antecedent basis for this limitation in the claim.

7. Claim 13 recites the limitation "said switch" in line 1. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1-3, 10, 12, 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Kaufman, U.S. Patent No. 5,491,752. Referring to claims 1-3, 10, 12, 13, Kaufman discloses a secure communication system wherein a plurality of workstations are authenticated by an authentication server and provided with a ticket (Figure 5 & Col. 8, line 66 - Col. 9, line 3), which meets the limitation of a sender device configured to initiate a first transmission across a communication link, a server linked to the sender device by the communication link, the server configured to receive a transmission initiated by the sender device, to verify the authenticity of the sender device, to initiate a second transmission to the receiver device, and to verify the authenticity of the receiver device, the system protects the anonymity of both the sender device

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and the receiver device. The tickets are used to encrypt/decrypt data sent between workstations in the network (Figure 5 & Col. 7, lines 24-29 & Col. 9, lines 3-9), which meets the limitation of a sender device configured to encrypt selected data for communication to a receiver device, the service further configured to permit linkage of the sender device and the receiver device for communication of the encrypted data without routing through the server following verification of authenticity of both the sender device and the receiver device, the receiver device configured to respond to the second transmission from the server and to receive the selected encrypted data from the sender device, and further configured to decryption the selected data, at least two modems, each communication with one of said two interfaces, said switch and said modems are digital, and the switch connects digital outputs of said modems.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

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12. Claims 4-8, 11, 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaufman, U.S. Patent No. 5,491,752, in view of Baratz, U.S. Patent No. 5,742,596. Referring to claims 4-6, 14, Kaufman does not specify the type of network that is utilized for communications in figure 5. Baratz discloses a network based communication system wherein the network can include public switched telephone network, private branch exchange, or wide area networks that can utilize T1 telephone connections (Col. 4, lines 6-34). It would have been obvious to one of ordinary skill in the art at the time of the invention to try one of the networks discussed in Baratz as the communication network in Kaufman because the networks have been identified as a finite number of networks that could be implemented by one skilled in the art in a predictable manner.

Referring to claims 7-8, 11, Kaufman does not disclose a billing system. Baratz discloses utilizing a billing system in the communication network (Col. 7, lines 50-59), which meets the limitation of a billing system for recording usage of said system, said billing system is connected to said public switched telephone network and is configured to submit charges to appear on a telephone bill of a user of said system, an auditing system for recording usage of said system, and for recording operational errors. It would have been obvious to one of ordinary skill in the art at the time the invention was made for the communication network of Kaufman to include a billing system in order to provide the capability for tracking system usage as taught by Baratz (Col. 7, lines 50-52).

13. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kaufman, U.S. Patent No. 5,491,752, in view of Baratz, U.S. Patent No. 5,742,596, and further in view of Anderson, U.S. Patent No. 5,283,829. Referring to claim 9, Baratz does not disclose payment for billed services electronically. However, it would have been obvious to one of ordinary skill in

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the art at the time the invention was made to provide for electronic bill payment in order to obviate the expense and hassle of paying bills via check and regular mail as taught by Anderson (Col. 1, lines 57-58).

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Hoffman, U.S. Patent No. 5,613,012

Feldbaum, U.S. Patent No. 6,446,206

Bellare, U.S. Patent No. 5,491,750

See, U.S. Patent No. 6,070,243

De Bruijn, U.S. Patent No. 5,428,745

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to BENJAMIN E. LANIER whose telephone number is (571)272-3805. The examiner can normally be reached on M-Th 7:00am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on 571-272-3799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Benjamin E Lanier/
Primary Examiner, Art Unit 2432